



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Case No. 97,223-I)

In re Application of:

Ravi Kapur, et al.

Serial No.: 09/624,131

Filing Date: July 21, 2000

For: Miniaturized Cell Array Methods and Apparatus for  
Cell-Based Screening

Group Art Unit 1641

Examiner: Lisa V. Cook

Confirmation No. 4910

**SUPPLEMENTAL**  
**INFORMATION DISCLOSURE STATEMENT**

**Mail Stop: RCE**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

Dear Sir:

Pursuant to 37 C.F.R. Section 1.97 - 1.99, the Applicant wishes to make the following references of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56. Copies of the references cited below are enclosed. These references are also listed on the enclosed PTO Form 1449. The enclosed references were cited in an Opposition to European Publication No. EP0983498.

In the judgment of the undersigned, portions of the listed references may be material to the Examiner's consideration of the presently pending claims. However, the references have not been reviewed in sufficient detail to make any other representation and, in particular, no representation is intended as to the relative relevance between references, whether cited in this or prior statements. This statement is not a representation that the listed references have effective dates early enough to be "prior art" within the meaning of 35 U.S.C. Section 102 or Section 103.

09/30/2005 ZJU HAR1 00000047 09624131

03 FC:1806

180.00 OP

This Information Disclosure Statement is being filed:

- ☐ within three months of the filing date of a national application; within three months of the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or before the mailing date of a first Office Action on the merits. 37 C.F.R. § 1.97 (b)
- ☐ **after** three months of the filing date of a national application, or the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or **after** the mailing date of a first Office Action on the merits, but **before** the mailing date of a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), and includes (37 C.F.R. § 1.97 (c):
- ☐ the Certification under 37 C.F.R. § 1.97(e) (see “Certification” below)

**OR**

- ☐ the fee of \$180 set forth in 37 C.F.R. § 1.17(p) (see “Fees” below).
- ☐ **after** a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), but before, or simultaneously with, the payment of the issue fee, and includes the Certification under 37 C.F.R. § 1.97(e) (see “Certification” below), and the Petition Fee set forth in 37 C.F.R. § 1.17(i) (see “Fees” and “Method of Payment of Fees” below). Applicants hereby petitions for consideration of the Information Disclosure Statement submitted herewith and the accompanying references in examination of the subject patent application.

#### CERTIFICATION

- ☐ The **undersigned** hereby certifies that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application not more than three months prior to the filing of the Information Disclosure Statement.
- ☐ The **undersigned** hereby certifies that no item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.

#### FEES

- ☐ No fee is owed by the applicant(s).
- ☒ The **IDS Fee of \$180.00** under 37 C.F.R. § 1.17(p) is enclosed herewith.
- ☐ The **Petition Fee of \$130.00** set forth in 37 C.F.R. § 1.17(i) is enclosed herewith.

**METHOD OF PAYMENT OF FEES**

- ☒ Attached is a check in the amount of \$180.00.  
☐ Charge Deposit Account No. 13-2490 in the amount of \$ . (A duplicate copy of this communication is enclosed for that purpose.)

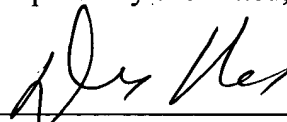
Please charge any underpayment or credit any overpayment in connection with this communication to Deposit Account No. 13-2490. A duplicate copy of this communication is enclosed for this purpose.

**CERTIFICATE OF MAILING AS "EXPRESS MAIL" (37 CFR 1.10)** I hereby certify that this correspondence and all attached paper(s) or fee(s) is being deposited with sufficient postage, with the United States Postal Service as EXPRESS MAIL POST OFFICE TO ADDRESSEE in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, with sufficient postage, on this 27<sup>th</sup> Day of September, 2005. under Express Mail Certificate No. EV596645468US.

Respectfully submitted,

Date:

9/27/05



David S. Harper

Registration No. 42,636

Telephone: 312-913-0001

Facsimile: 312-913-0002

**McDonnell Boehnen Hulbert & Berghoff LLP**  
300 South Wacker Drive, Suite 3100  
Chicago, IL 60606

**United States Patents**

1. D. Lansing Taylor, U.S. Provisional Patent Application No. 60/018,696, Filed: May 30, 1996.
2. Kirk Schroeder, et al., U.S. Patent No. 5,355,215, Issued October 11, 1994.
3. Jeffrey H. Price, et al., U.S. Patent No. 5,548,661, Issued August 20, 1996.

**Foreign Documents**

4. James Bacus, et al. PCT Published Patent Application No. WO 87/02802, Published May 7, 1987.
5. Robert Moore, et al., PCT Published Patent Application No. WO 94/11841, Published May 26, 1994.

**Other Documents**

6. Waggoner, et al., (1996) *Human Pathology*, Vol: 27(5), pp. 494-502.
7. Benveniste, et al., (1989), *The Journal of Cell Biology*, Vol: 109, pp. 2105-2115.
8. Carey, et al., (1996), *The Journal of Cell Biology*, Vol: 133(5), pp. 985-996.
9. Kolega, et al., (1993), *Bioimaging*, Vol: 1, pp. 136-150.
10. Farkas, et al., (1993), *Annu. Rev. Physiol.*, Vol: 55, pp. 785-817.
11. Böcker, et al., (1996), *Phys. Med. Biol.*, Vol: 41, pp. 523-537.
12. Pepperkok, et al., (1993), *Experimental Cell Research*, Vol: 204, pp. 278-285.
13. Article on Business Wire Website (May 28, 1996), ArrayScan System Introduces High Throughput Cell-Based Screening, Biological Detection, Inc., 1 page.
14. Article on Business Wire Website (June 3, 1996), New Chain of Scientific Advisory Committee Brings Fluorescence Expertise, The Board of Directors of Biological Detection, Inc., 1 page.
15. Article on Business Wire Website (September 25, 1996), Biological Detection, Inc. and Carl Zeiss Yena, GmbH of Germany form worldwide strategic alliance in drug discovery, 1 page.
16. Article on BioCentury Archives, (September 30, 1996), Biological Detection, Inc. and Carl Zeiss, Drug Discovery, 1 page.
17. Article on Business Wire Website (October 15, 1996), Biological Detection, Inc. Changes name to BioDx, Inc., 1 page.
18. Hanakam, et al., (1996), *The EMBO Journal*, Vol: 15(12), pp. 2935-2943.
19. Cole, et al., (1996), *Molecular Biology of the Cell*, Vol: 7, pp. 631-650.
20. Machiels, et al., (1996), *European Journal of Cell Biology*, Vol: 70, pp. 250-259.
21. Yasuhara, et al., (1997), *Genes to Cells*, Vol: 2, pp. 55-64.
22. Article on Business Wire Website, (October 8, 1996), BDI appoints VP of Business Development from Beckman Instruments, Biological Detection, Inc., 1 page.
23. Mark V. Rogers, (1997), *DDT*, Vol: 2(4), pp. 156-160.
24. Giuliano, et al., (1997), *Journal of Biomolecular Screening*, Vol: 2(4), pp. 249-259.
25. Böcker, et al., (1995), *Cytometry*, Vol: 19, pp. 283-294.
26. Article on BioDx, Inc. Website, (1996), What's new at BioDx, 11 pages.
27. Article on Business Wire Website, (June 3, 1996), New chair of Scientific Advisory Committee brings Fluorescence expertise, 1 page.

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32. Article on BioDx Home Page, (1997), Solutions for Cell Screening, 25 pages.

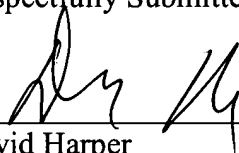
In accordance with MPEP Sections 609 and 707.05(b), it is requested the document cited (including any cited in applicant's specification which is not repeated on the attached Form PTO-1449) be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing on Form PTO-1449. Such initialing is requested even if the Examiner does not consider a cited document to be sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with. This is requested so that each document becomes listed on the face of the patent issuing on the present application.

Respectfully Submitted,

Date:

9/27/05

By:



David Harper

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300 South Wacker Drive, Suite 3100

Chicago, IL 60606

FORM PTO-1449  
(Rev. 2-32)

U.S. Department of Commerce  
Patent and Trademark Office

Atty. Docket No.

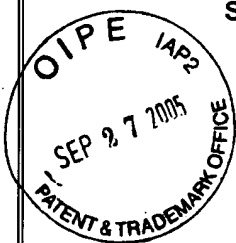
97,223-I

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**SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use several sheets if necessary)



**Applicant:**

Kapur, et al.

**Filing Date:**

July 21, 2000

**Group:**

1641

**U.S. PATENT DOCUMENTS**

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date if Appropriate
	1.	U.S. Provisional Patent Application No. 60/018,696		D. Lansing Taylor			May 30, 1996
	2.	5,355,215	October 11, 1994	Kirk Schroeder, et al.			Sept 30, 1992
	3.	5,548,61	August 20, 1996	Jeffrey H. Price, et al.			Sept 7, 1994

**FOREIGN PATENT DOCUMENTS**

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							Yes	No
	4.	WO 87/02802	May 7, 1987	PCT			X	
	5.	WO 94/11841	May 26, 1994	PCT			X	

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc).**

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication.

FORM PTO-1449  
(Rev. 2-32)

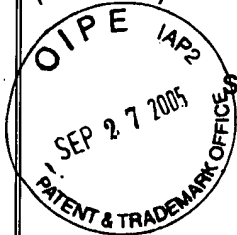
U.S. Department of Commerce  
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<b>FORM PTO-1449</b> <b>(Rev. 2-32)</b>  <b>SUPPLEMENTAL INFORMATION DISCLOSURE</b> <b>STATEMENT BY APPLICANT</b> (Use several sheets if necessary)	<b>U.S. Department of Commerce</b> <b>Patent and Trademark Office</b>	<b>Atty. Docket No.</b>  97-223-I	<b>Serial No.</b>  09/624,131
		<b>Applicant:</b>  Kapur, et al.	
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